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JAN 29, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Golf Pro, Inc.

Serial No. 74/579,163

Marie V. Driscoll of Robin, Blecker, Daley & Driscoll for
applicant.

Amos T. Matthews, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney).

Before Simms, Hohein and Walters, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Golf Pro, Inc. has filed a trademark application to
register the mark GOLF PRO for "hotel and condominium
services featuring golf."¹

The Trademark Examining Attorney has finally refused
registration under Section 2(e)(1) of the Trademark Act, 15
U.S.C. 1052(e)(1), on the ground that applicant's mark is
merely descriptive of its services.

¹ Serial No. 74/579,163, in International Class 42, filed September 27,
1994, based on an allegation of a bona fide intention to use the mark in

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

The test for determining whether a mark is merely descriptive is whether the involved term immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of a product or service. *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

The record includes excerpts of articles from the LEXIS/NEXIS database which support the Examining Attorney's contention that GOLF PRO is a term recognized by the relevant public as referring to a professional golfer and

commerce. The application includes a disclaimer of the term GOLF apart

that hotels, particularly resort hotels, employ golf pros.²

Following are several examples:

. . . ocean-view accommodation, plus free golf, use of golf kit and motorised (*sic*) caddy, and two practice rounds with a hotel golf pro. Book through Elegant Resorts . . . *Daily Mail*, March 26, 1994.

"The most consistent factor in Mexico is the weather," says Wayne Sisson, golf pro at the Acapulco Princess Hotel and Resort and its sister course at the neighboring Pierre Marques Hotel. "Its a good situation for a golfer." *Newsday*, November 17, 1991.

Hotels boast of offering golf pros and tennis pros, but softball pros? The new downtown hotel Checkers says in a newspaper ad that job . . . *Los Angeles Times*, February 1, 1989.

Applicant readily admits that "[t]here are individuals who are golf professionals"; that "[t]hey are sometimes referred to as golf pros"; that "[s]ome hotels have golfing facilities"; and that "[s]ome of these hotels employ golf pros." Applicant contends, however, that:

GOLF PRO, [considered in connection with hotel and condominium services], could suggest one of several things - that the golf courses available at the hotel or condominium are of a professional quality; that the courses are designed for use by experienced golfers and not 'hackers'; that a golf professional is employed to advise players; or more generally that this is a serious place, intended for pros who take their golf seriously.

from the mark as a whole.

² In his brief the Examining Attorney stated that "a person achieves the title of 'GOLF PRO' through years of playing and has completed a certification process by a golf association. Today's golf players have come to recognize that GOLF PRO identify (*sic*) a certify (*sic*) professional golfer. Most golf courses, private or public[,] have a GOLF PRO on staff." While the Examining Attorney provided no evidence in support of these statements, we find such information unnecessary to our decision in this case.

Arguing that the Examining Attorney's position is inconsistent with prior Office practice, applicant listed numerous third-party registrations which include either the term GOLF or the term PRO. However, such a list does not place those third-party registrations properly before us in this record and, thus, we have not further considered these registrations.³ We note, moreover, that our decision would be unaffected by consideration of these registrations as none includes the mark GOLF PRO, there is no indication of whether any terms are disclaimed in the registration, and, where goods or services are indicated, the registrations do not pertain to the same or similar services as herein. Furthermore, each case must be decided on its merits based on the record in that case.

We note applicant's disclaimer in the record of the term GOLF. However, in connection with the present case, we find GOLF PRO to be a unitary phrase. As applicant admits, a GOLF PRO is an individual who is a professional golfer, and hotels with golfing facilities may employ a GOLF PRO. Further, while applicant contends that GOLF PRO, considered in connection with its services, could suggest several different things, applicant provides no evidence indicating

³ In order to make registrations of record, soft copies of the registrations themselves, or the electronic equivalent thereof, i.e., printouts of the registrations taken from the electronic records of the Patent and Trademark Office's (PTO) own data base, must be submitted. See, *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992).

that consumers would make these other associations. Rather, the record establishes that the term GOLF PRO, as used in the press to refer to such individuals, is likely to be perceived by the relevant public as referring to a professional golfer.

It is our view that, when applied to applicant's services, the entire phrase GOLF PRO immediately describes, without conjecture or speculation, a significant feature or function of applicant's services, namely, either that the golf "featured" in connection with applicant's hotels and condominiums includes the services of a golf pro to instruct guests and residents, or that the hotel or condominium is owned or run by golf pros. Either of these connotations renders the term GOLF PRO merely descriptive of a significant aspect of the hotel or condominium services. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's services to readily perceive the merely descriptive significance of the term GOLF PRO as it pertains to those services.

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Decision: The refusal under Section 2(e)(1) of the Act
is affirmed.

R. L. Simms

G. D. Hohein

C. E. Walters
Administrative Trademark Judges,
Trademark Trial and Appeal Board